

## REMARKS

Claims 1-9 and 17-19 have been amended and claims 26 and 27 have been added.

### Claims 1-9 and 17- 19

Claims 1-9 and 17-19 have been amended to be method claims to satisfy the Examiner's section 112 rejection.

### Claims 1-6, 8-12, 14, 17-19 and 23-24

Claim 24 has been deleted.

The remaining claims stand rejected in view of the combination of Marks and Wood.

The Examiner concedes that Marks does not disclose exchanging cards as recited in claims 1, 10, 17 and 23-24, or that an additional card can be exchanged with one of the corner cards, as recited in claim 4. To find these missing elements, the Examiner has looked to Wood and combined the two references, supposedly to arrive at the claimed invention. However, this is improper for several reasons explained below, which are support by the Declaration of Mr. Tony Celona, Vice President of Video Gaming Operations and Marketing at Yonkers Raceway, and responsible for installing 5,500 video gaming terminals; and before that Vice President, Slot Operations for Foxwoods Casino, which is the largest casino in the world. At Foxwoods, Mr. Celona was responsible for over 7,000 video slot machines. Prior to Foxwoods he was Vice President of Slot Operations at Trump Taj Mahal Casino in Atlantic City and was

responsible for 3,800 slot games. He is recognized by his peers as a leading expert in the field.

Altogether Mr. Celona has 24 years of experience in the gaming industry.

One of the games Mr. Celona reviewed was a game called “Big E” that was based on Marks’ disclosure in the 5,882,260 patent (Celona Dec. ¶ 8), which the Examiner has relied on. For reasons explained in more detail below, the Marks patent would not have rendered the claimed inventions obvious alone or in conjunction with the Wood disclosure.

**The Applicant’s Invention and the Prior Art Must Be Considered As A WHOLE**

As explained in MPEP § 2141.02, Applicant’s invention must be considered in its entirety; that is it cannot be dissected into discrete parts which are then matched piece-by-piece with the prior art:

“In determining whether the invention as a whole would have been obvious under 35 U.S.C. 103, we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question ... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification... Just as we look to a chemical and its properties when we examine the obviousness of a composition of matter claim, it is this invention as a whole, and not some part of it, which must be obvious under 35 U.S.C. 103.” (Citations omitted; underline added).

Although the cards themselves are old, the different strategies and decisions required to play Applicant’s inventions (which for the most part is what all new poker game and card-game patents are about) are entirely new. These “properties of the subject matter which are inherent ... and are disclosed in the specification” are, because

of the combination of an innovative layout and card exchanges, entirely novel and require new strategies and player decisions that have never been disclosed before.

Although a player's strategies and thought processes cannot be patented, the games that permit (or require) these strategies can be; these strategies are intrinsically interwoven in the claimed inventions are integral to and an "inherent" part of Applicant's inventions. The resulting games are completely new, test players' skills in ways that are completely novel, creative and are fun to play. Applicant believes they are games that casinos will embrace because they are faster to play and more interesting than the prior art.

It is critically important to recognize that the arrangement of the cards in Applicant's inventions is not the only new feature of the games, nor is the card arrangement alone, the only new feature in any of the prior art. To the extent the Examiner argues that the card arrangement alone is not patentable, that is not the appropriate test to determine patentability. The Examiner must consider the novel results that are part of the inventions.

Moreover, not only must the claimed invention be considered as a whole, but each prior art reference must also be considered in its entireties: "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP §2141.02 (emphasis in original). Therefore it is imperative that: "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP 2141.02 (emphasis in original).

With these rules in mind it is important to consider the game Marks has disclosed -- the entire game -- not just one of many ways his cards are displayed.

First, the disclosure of Marks' patent, which is consistent in all his games, requires players to fill in a "hand pattern" one card at a time. (See col. 3, lines 65 - col. 4, line 5, col. 5, lines 55-64; col. 6, lines 53 - col. 7, line 6; 65 and col. 59 - 60). This is the fundamental teaching of Marks, and cannot be ignored.

For each of the 19 cards dealt in Marks' Hand Pattern shown in columns 89 and 90, which the Examiner relies on, the player must consider which of the remaining spaces would maximize the expected value of the resulting hands. If one considers the Hand Pattern figure the Examiner has cited (Marks columns 89 and 90), the Examiner will quickly see one of the problems of Marks' game: The game is too slow to be commercially viable because the player must evaluate 19 cards one at a time, and decide which of the spaces (starting with 19 empty spaces) to deposit the card. If each consideration takes the player 5 seconds, the game will take 95 seconds. Casinos want poker games to be played in the 5 to 10 second range. (Celona Dec. ¶ 10). Therefore, Marks' games, which would take over a minute and a half to play, is too slow for commercial casino setting and for this reasons has not been successful. (Celona ¶¶ 8 - 9). One cannot simply view a single Hand Pattern of Marks' 150-column patent and conclude that Applicant's inventions would have been obvious. The entire patent must be considered. Any other analysis is inconsistent with the law on obviousness.

It bears emphasis that Marks' Hand Pattern that the Examiner relies on is never dealt automatically in that format. Rather, the cards are dealt one at a time, with

the player determining the locations, until the entire pattern is complete. (Celona Dec. ¶ 8).

By contrast, in Applicant's inventions are entirely different and the strategy is completely distinctive from Marks, as are the rules of play and the card display. (Celona Dec. ¶ 10). In Applicant's invention at least 12 cards are dealt face up at the outset, allowing the player to see all 12 face-up cards immediately and further giving him some insight into the remaining cards in the deck. The result is that Applicant's invention plays faster than Marks' game and provides critically useful information to the player to help him make informed decisions about what strategy to follow. (Celona Dec. ¶ 11). The physical location of each selected card is not a factor in the game play, as it is in Marks, and therefore the speed of play is increased. (Celona Dec. ¶ 11).

In Marks' game at the beginning, the player sees only the first card dealt; he only knows nothing about the remaining 51 cards in the deck. At the same stage in Applicant's game the player knows the identity of 12 to 16 cards (he knows all 16 cards if the corner cards are dealt face up in the four-hand version of the game; he would know the identity of more cards in the 6, 8 and 10 hand versions). It is not until towards the end of Marks' game, after 16 cards are dealt, one at a time, that the player knows the identity of 16 cards, information the player has at the beginning of Applicant's games.

Also, the decisions in Marks are about the locations of where cards are placed requires one decision point for each card as it is dealt. By contrast Applicant's game requires far fewer decisions. Applicant's game is entirely different from Marks' many decisions about where to place cards one at a time.

As explained above, the MPEP requires prior art to be considered as a whole. Therefore, when considering Marks as prior art, the Examiner must consider that Marks' teaching is a card game where each card is displayed to the player one at a time, that plays slowly and that has entirely different strategies and player decisions. Applicant respectfully states that focusing on a single Hand Pattern in Marks' voluminous patent is a mistake.

Wood does not add anything to the omissions in Marks. Wood does not address the complex strategies and decisions the player faces in Applicant's inventions. Instead, Wood permits the player to exchange cards, but only in certain circumstances. As the Applicant has done, Wood seeks to create a game that has different strategies and decisions from the prior art. The problem with Wood is that before the swap may be made there are two relatively complicated prerequisites that must exist (see col. 4, lines 22 - 35). Wood does not provide any guidance or suggestion to combine its layout and strategy with Marks. (Celona Dec. ¶ 13). Furthermore, neither Wood nor Marks include revealing the identity of some of the cards at the end of play as in Applicant's claims 2 and 18.

This disclosure as a whole would not lead a person of ordinary skill in the art to consider combining it with Marks. (Celona Dec. ¶ 14). Marks' one at a time game does not lend itself to swapping and Wood does not suggest a multihand game like Applicant's where common corner cards add to the complexity and challenge. (Celona Dec. ¶ 15), and neither suggests turning cards up at the end of play.

The Examiner states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Marks to include exchanging

cards from one hand to another as taught by Wood to provide game players a chance to modify their poker had [sic] to increase their chances for a better reward.” (page 5). Applicant strongly disagrees with this conclusion. Marks could never be used in any sensible configuration to have swapping. (Celona Dec. ¶ 16). As previously explained, in the configuration of Marks that the Examiner has relied on, 19 cards are dealt one-at-a-time. In Marks, when would the swapping take place? After each card is dealt? After all 19 cards are dealt? If somehow Marks and Wood were combined, using Marks’ Hand Patterns and Woods swapping, the game would be too slow to have any commercial applicability. (Celona Dec. ¶ 16).

In Wood the player must have a “qualifying hand,” which Wood explains is a pair of 7’s or better (col. 2, lines 43-46), before the exchange feature is available. Applicant’s invention does not require a threshold hand before a player can swap cards. Wood is more like a bonus game. You must have a winning hand before the exchange feature is available. In Applicant’s invention, swapping is always available.

In Wood there are no common cards. And there is no teaching in Wood that would allow a person skilled in the art to add common cards to the two separate five-card hand arrangements. (Celona Dec. ¶ 15). It is altogether unclear, without resorting to impermissible hindsight, how one could modify Wood to have common cards. See e.g., (Celona Dec. ¶ 17).

Moreover, there is no motivation or teaching to convert Wood into a game where cards are arranged in a polygon, where each side is a separate hand. (Celona Dec. ¶ 18).

Again, the strategy in Applicant's invention is entirely different because in Wood all ten cards are visible and the player can exchange cards from one hand to the other. By contrast in Applicant's invention, in claims 2 and 10 for example, only three of five cards are visible in each hand, and there are four interconnected hands displayed. In the games of these claims, for example, Applicant's invention is far more difficult than Wood because the player does not have all the information about each of the five cards in the hand. Additionally, the swapping strategy in Wood is much simpler. In Wood there are only two choice; swapping from hand 1 to hand 2. By contrast the swapping strategy in Applicant's inventions requires considering swapping to any of at least three different hands, and in some cases swapping the same card from a second hand to a third hand. (See new claim 26). New claim 27 adds a limitation that restricts the card swaps to a predetermined number.

Neither patent suggests any way to combine the two disclosures to make a playable game, and any combination of the two without extensive reconstruction that must be based purely on hindsight teaching from Applicant's disclosure, would yield a useless result. (Celona Dec. ¶¶ 14 to 18).

As the MPEP make plain, this hypothetical combination cannot be done, and would never have been done by a person of ordinary skill in the art:

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." (MPEP 2143.01 and .02).

The Examiner's proposed modification of Marks, using Wood, runs afoul of these two rules. First, the modification would make the resulting game "unsatisfactory for its intended purpose." Second, the proposed modification entirely "change[s] the principle" of Marks. Allowing exchanges after the player makes an initial set of decisions as to card locations, renders that initial set of decisions moot or irrelevant – the decision set is a key principle of Marks. This combination, therefore cannot be done, and would not have been done by the person of ordinary skill in the art. (Celona Dec. ¶¶ 14-19).

Wood would point a person of ordinary skill in the art in an entirely different direction, one that involved swapping cards based on a complicated mathematical algorithm. Wood does not provide any guidance or suggestion to combine its layout and strategy with Marks. (Celona Dec. ¶ 17).

There is an additional problem with the Examiner's argument. Because the Examiner has taken isolated elements of the claimed inventions and located them in the prior art instead of evaluating the inventions as integrated wholes and comparing that to the prior art as a whole he has overlooked the basic teachings of Marks and Wood, and instead focused on individual claim elements.

This is inconsistent with the rule that was recently restated by the Federal Circuit in, Abbott Laboratories v. Syntron Bioresearch, Inc. Slip-op. 02-1203 -1257 (Fed. Cir. July 10, 2003):

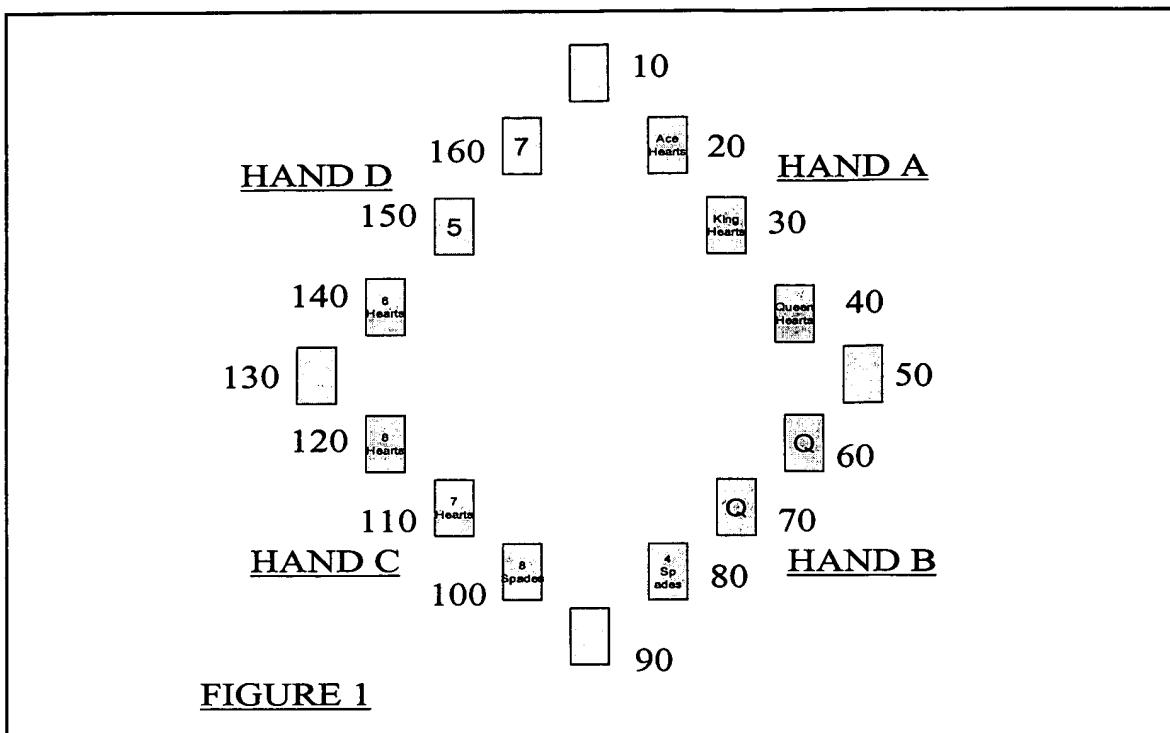
"Knowledge in the prior art of every element of a patent claim, however, is not of itself sufficient to render claim [sic] obvious."

Finally, Applicant has selected their shapes to look unconventional and to distinguish them from typical games (which for the most part are strictly horizontal or vertical see e.g., Marks, Wood, Gajor ("The cards are dealt in a traditional horizontal

fashion..." col. 2, lines 35-37), which Applicant believes will differentiate his invention from commercially available games, and will intrigue and influence players to use the game. Restated the Applicant has followed an distinctly unique path that is inconsistent with the teaching of the prior art. (Celona Dec. ¶ 19).

The following illustrations will further help the Examiner understand the significant differences between the claimed inventions and the prior art.

Applicant's novel approach adds an entirely new strategy to video poker games because the player's several hands are linked with common cards, and swapping cards can improve one hand while simultaneously making the adjacent had worse. No other card game has these unique properties, and the prior art would not have suggested these innovations to a person of ordinary skill in the art. For example, if the player is dealt the hands as shown below, he would be required to consider entirely new strategies that have never been used before, to solve new problems that do not exist in any prior art game and thus, would be playing a game that never existed before, nor is there any suggestions to create such a game.



For example, the player must address the complex, multi-varient decisions posed by this game. Hand A has a potential royal flush, straight flush, straight and flush. However, if the player exchanges the Queen from Hand A (card 40) with the 4 from Hand B (card 80), he will have a sure three of a kind in Hand B (three queens), but he will forego the potential very high payout from the royal flush, etc. in Hand A. For one possible payable, the player must decide if he prefers his chance of getting an 800 to 1 payout on the royal flush and leave the cards the way they are, or if he should exchange cards and forego the sure three of a kind payout of 3 to 1 (but keep the 2 to 1 payout for the pair of Queens in Hand B).

Hand D has a possible straight (5, 6, 7). But, because two 8's and a 4 have already been dealt (cards 100 and 120 and 80) the chances of completing a straight (e.g., 4, 5, 6, 7, 8) are diminished. Thus, the player must decide whether to swap card 100 (8 of spades) for card 140 (6 of hearts), making the straight in Hand D difficult, but try for a

flush in Hand C (all Hearts). Alternatively, the player could swap cards 140 and 110, giving him a pair of 7's in Hand D and a pair of 8's in Hand C. With two pair's his odds of getting a paying three of a kind, or possibly a full house are increased, but are they greater than the expected pay off of the previous strategy? More importantly, neither Wood, which has only two hands and only permits swapping under certain circumstances, nor Marks, which has no swapping of any kind, suggests in any way these complex strategies that are inherent in Applicant's games.

#### There Was No Motivation to Combine

In addition to the requirements set forth above, it is critically import to show a motivation to combine references. The MPEP states this requirement as follows:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP § 2142.

“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

MPEP § 2142.

The Examiner has not pointed to any motivation to combine these dissimilar references.<sup>1</sup> The closest the Examiner has come to identifying a motivation to combine is: that exchanging cards “would provide game players a chance to modify their poker had [sic] to increase their chances for a better reward.” (Page 5). This generalized statement, however, is not a motivation to combine the two references, Marks and Wood, the Examiner has cited.

Moreover, Mr. Celona has explained that in his opinion, a person of ordinary skill in the art would not have been motivated to combine these references. (See Celona Dec. ¶¶ 13, 14 and 17).

“A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.” MPEP § 2143.01 (emphasis added). The Examiner has not pointed to any “objective reason” to combine these disparate references.

Even if each claimed element is separately known in the prior art, that fact alone is not enough to show obviousness. As stated in the MPEP, “[t]he mere fact that references can be combined or modified does not render the resultant combination

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<sup>1</sup> Because the Examiner has not pointed to any motivation to combine any of the references, it is unclear where the supposed source of a motivation to combine is. MPEP § 2144.03 (“When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. See 37 CFR 1.104(d)(2)”).

obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01 citing In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)(emphasis in MPEP).

The MPEP makes it plain that the combinations the Examiner has made and the conclusion reached are improper:

“Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. ‘The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’” MPEP § 2143.01

It is equally, critically important to recognize that “the person of ordinary skill in the art is an objective legal construct presumed to think along conventional lines without undertaking to innovate, whether by systematic research or by extraordinary insights.” Life Technologies, Inc. v. Clontech Laboratories, Inc., 224 F.3d 1320, 1325 (Fed. Cir. 2000). This person does not look for creative solutions, and does not consider how to completely redesign existing games to arrive at novel, challenging ones that have heretofore been unknown. “A person of ordinary skill in the art is also presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive, systematic research or by extraordinary insights, it makes no difference which.” Std. Oil Co. v. Am. Cyanamid Co., 774 F.2d 448, 454 (Fed. Cir. 1985)(Emphasis added).

These immutable rules are intended to prevent the Examiner from falling into an improper hindsight analysis, that is, where the Examiner uses teaching and information in the pending application as a guide to assemble disparate prior art references.

As the Federal Circuit has explained in In re Fritch 972 F.2d 1260, 1266 (1992):

“[I]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’” (Footnotes omitted).

And, as the MPEP explains:

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person. Knowledge of applicant’s disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the ‘differences,’ conduct the search and evaluate the ‘subject matter as a whole’ of the invention. The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” MPEP § 2142 (Emphasis added).

#### Even if Combined The Reference Do Not Result in The Claimed Inventions

In any case, even if there were a motivation to combine, and there is none, the Examiner’s obviousness conclusion is inconsistent with the prevailing law as enunciated in the MPEP.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP § 2143.03 (emphasis added).

For example, these two limitation of claims 1 would not be present in the combination of Wood and Marks for the reasons stated above: “[a]dealing cards [altogether at the outset] in a four sided, diamond shape, each side is a separate hand that has five cards, consisting of three interior cards and two corner cards, the corner cards are shared with two adjacent hands,” [b] a player can exchange cards from one [adjacent] hand to another hand.” (Celona Dec. ¶ 18).

These ground rules demonstrate Applicant’s invention would not have been obvious to a person of ordinary skill in the art for at least three key reasons: (1) the differences between the references and the claimed invention are considerable; (2) there was no motivation to combine them; and (3) even if these references were combined, they would not yield Applicant’s invention. (Celona Dec. ¶¶ 14-19).

#### OTHER REFERENCES

The Examiner cited Garrod for the proposition that wild cards are well known. (See discussion about claims 7 and 11, page 6). Applicant has made no claim that he invented wild cards. It is true they were well known. However, using wild cards in the novel games Applicant has claimed is a unique adaptation of these cards. This rule is set forth in the M.P.E.P.: “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP §2141.02 (emphasis in original). “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. MPEP 2141.02. (Emphasis in original).

Garrod does not disclose swapping, common cards or multiple hands as in Applicant's invention. As explained above, because Garrod is basically a series of single hand games, the strategy is entirely different from Applicant's

There is no suggestion in Garrod about how it could be modified to have swapping, and there is no motivation to combine Garrod with Marks or Wood.

Wachtler discloses "buying New cards" (col. 1 lines 5 – 10). Buying new cards is entirely different from paying for the right to swap existing cards. Buying new cards replaces existing cards with the expectation that the unknown new cards will be better. In the extreme case, the player can get an entirely new hand. By contrast, swapping, as explained above, requires the player to redistribute existing cards. The difference is fundamental: one attempts to improve a hand by acquisition (i.e., entirely new unseen cards) versus by rearrangement (i.e., known cards with serious inter-relationship issues, as explained above ), or in other words, an uncertain outcome versus a known one. Furthermore, swapping may improve one hand while making another hand worse. There is no comparable result with replacement. Wachtler's replacement only affects a single hand and is, therefore, not comparable to an exchange. Thus, Wachtler includes an uncertain outcome from his purchase versus a known outcome in Applicant's, and each purchase affects only one hand versus Applicant's two. Wachler does not address these issues, and he does not have common cards.

Again, Applicant's invention as a whole must be considered. It is impermissible to compare parts of the invention with snippets of the prior art.

CONCLUSION

Applicant believes the claims are now in condition for allowance and respectfully requests reconsideration together with a favorable determination.

Respectfully submitted,



DA Loewenstein 10/19/2009

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